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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,055	02/07/2001	Yuichi Asami	Q62904	7352

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EXAMINER

CAPRON, AARON J

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,055

Applicant(s)

ASAMI ET AL.

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

MARK SAGER
PRIMARY EXAMINER

DETAILED ACTION

Information Disclosure Statement

Regarding the Information Disclosure Statement, filed on December 12, 2001, the examiner's consideration under MPEP 609 of the non-English language references cited on submitted Information Disclosure Statement is limited to the extent described for the cited non-English documents and any corresponding translations therein only so far as the particular portion respectively translated and without reference to a complete invention thereof. It is further noted that the translations are not attested as to their accuracy.

Claim Objections

Claims 19 and 20 are objected to because of the following informalities:

Claims 19 and 20 are duplicate claims. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims state, "A computer program for..."

Claims 30-32 are a program per se which is held to be non-statutory *Warmerdam 33F.3d at 1361, 31 USPQ2d at 1760*. The claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permits the data structure's functionality to be realized. The applicant is

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claiming non-functional descriptive material on a computer medium. By simply amending the claim to state "A computer readable storage medium, for building a crossword template, on which are code segments that..." would not be sufficient. The applicant must clearly define structural and functional relationships between the code and the hardware/software components. Please refer to MPEP section 2106.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-23, 25-29 and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (U.S. Patent No. 5,592,609; hereafter "Suzuki").

Suzuki discloses a game machine that includes the ability to edit the game music, the music editor permits the music attributes to be changed for each sound course and to be changed in real time while the music is being played back (Figures 14-15A and 16:20-67). The music editor edits the music at any particular time during game play, therefore a player has the ability to adjust the beginning and/or ending portion of the game, depending upon if the player feels that a change to the game is needed. Since the music is adjusted at real time the timing data and connection data are adjusted automatically to make a smooth transition between different sounds.

Referring to claims 2 and 3, Suzuki discloses the ability to adjust the volume (Figure 15 and 16:35-46).

Referring to claims 4-6, Suzuki discloses the ability to adjust the tempo of the music real time to determine the desired tempo of the music (Figure 15A; 15:28-45 and 16:20-67).

Referring to claims 33-35, Suzuki discloses the ability to adjust the tempo of the music based on the tempo from the main portion of the song to the preamble and post amble (Figure 15A; 15:28-45 and 16:20-67).

Referring to claims 7-9, Suzuki discloses a game machine that has the ability to store the edited music data (31:56-32:3).

Referring to claim 10, Suzuki discloses a game machine that has original music storage means, original music end timing storage means, connection music storage means (16:56-67), original music reproduction means, main part end timing monitoring means, connection music output means and volume control means (Figure 15A).

Referring to claims 11 and 12, Suzuki discloses a game machine that has original music storage means, main part start timing storing means, connection music storage means, original music reproduction start timing storage means, connection music output means, original music reproduction start timing monitoring means, original music reproduction means, main part start timing monitoring means and volume control means (Figure 15A), the volume not adjusting as the music is reproduced.

Claims 13-15 correspond in scope to a method set forth for use of the game machine listed in claims 1-12 and are encompassed by use as set forth in the rejection above.

Claims 16-18 correspond in scope to an information storage medium set forth for use of the game machine listed in claims 1-12 and are encompassed by use as set forth in the rejection above.

Claims 19-20 correspond in scope to a distribution device set forth for use of the game machine listed in claims 1-12 and are encompassed by use as set forth in the rejection above.

Claims 21 correspond in scope to a game machine set forth for use of the game machine listed in claims 1-12 and are encompassed by use as set forth in the rejection above.

Referring to claim 22, Suzuki discloses a game machine of which controller is operated by a player in accordance with game music, the machine including input means for setting a play conditions, storage means for storing the play conditions and game advancing means for advancing a game according to the play condition stored wherein the game advancing means includes the ability to output music relating to the game, the ability to change and control the music in real time based upon player's preferences by adjusting the music editor.

Referring to claim 23, Suzuki discloses the game advancing means further comprises timing guidance image display means for displaying timing guidance image in conformity with the play condition stored in the play condition storage means, for guiding timing at which the player is to operate the controller in accordance with the game music (Figures 7-8).

Claims 25-29 correspond in scope to a game machine set forth for use of the game machine listed in claims 1-12 and are encompassed by use as set forth in the rejection above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki.

Referring to claim 24, Suzuki discloses a game machine of which controller is operated by a player in accordance with game music, the machine including input means for setting a play conditions, storage means for storing the play conditions and game advancing means for advancing a game according to the play condition stored wherein the game advancing means includes the ability to output music relating to the game, the ability to change and control the music in real time based upon player's preferences by adjusting the music editor, but does not disclose that the original music determination means determines the original music to output based on a random number. However, it is notoriously well known in the art to use random music in order to update the game so the sound does not create redundancy in the game. The random generation of sound could ensure that the game would create interest in the game for a longer period of time. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the random generation of the music to Suzuki's invention in order to create a game that is non-repetitive in nature and therefore, could keep player's attention for a longer time period.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc
September 18, 2002

A handwritten signature in black ink, appearing to read 'MS', is positioned above the printed name and title.

**MARK SAGER
PRIMARY EXAMINER**